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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

M.W. CARROLL et al.

Application No.: 09/533,798

Filed: 24 March 2000

For: Polypeptide

Customer No.: 20350

Confirmation No.: 2448

Examiner: L. Scheiner

Technology Center/Art Unit: 1648

RESPONSE TO RESTRICTION  
REQUIREMENT

RECEIVED  
SEP 3 0 2003  
TECH CENTER 1600/2900

Mail Stop Non-fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in reply to a Restriction Requirement mailed 22 August 2003, which set 22 September 2003 as the initial deadline for response. Accordingly, this Response is believed to be timely filed and no extension of time is believed to be required.

Claims 1-4, 6, 8-16, 18-34, and 41-52 are pending, with claims 1-4, 6, 8, 13, 15, 18-34, and 41-45 withdrawn from consideration based upon an election filed 02 January 2003 in response to a previous Restriction Requirement mailed 02 October 2002 (Paper No. 10).

Thus, claims 9-12, 14, 16, and 46-52 are pending. This is consistent with the position set forth in the instant Restriction Requirement, which alleges that an election of a single sequence set forth in claim 50 or 51 is required without restriction among any of the other claims. Applicants believe that upon election as required, claims 9-12, 14, 16, 46-50 and 52, along with at least one sequence from claims 50 and 51, will be examined on their merits in their entireties.

Reconsideration and modification or withdrawal of the Restriction Requirement is respectfully requested in light of the following remarks.

The Restriction Requirement alleges that the inventions represented by SEQ ID NOs: 5 through 27 as recited in claims 50 and 51 are "unrelated" because they are "each distinct in structure (primary amino acid sequence)." Moreover, the Restriction Requirement asserts that "the search required for a particular sequence identifier is not required for any of the remaining sequence identifiers".

Without acquiescence to the position set forth in the Restriction Requirement as indicated by the above quoted statements, Applicants respectfully submit that a different view of claims 50 and 51 is necessary due to a fundamental error in the Restriction Requirement. The fundamental error is in the failure to recognize that claims 50 and 51 are genus claims governed by the standard set forth at M.P.E.P. 806.04(d) *et seq.* Applied to instant claims 50 and 51, the vaccine compositions comprising a modified 5T4 antigen comprising a peptide sequence represented by one of SEQ ID NOs: 5 to 27 are each a species within the genus of claims 50 and 51. Accordingly, an election of species as set forth at M.P.E.P. 809.02(a) *et seq.* would have been the more proper Restriction Requirement to be presented in the instant Office Action.

In light of the reasons provided above, Applicants respectfully submit that the requirement for the election of a single sequence may be properly considered to be a election of a single species to facilitate search and examination. If no prior art is found to anticipate or render obvious the elected species, Applicants respectfully submit that the search of the claims should be extended to the next species.

Finally, Applicants respectfully point out that the nature of claims 50 and 51 as genus claims does not alter the fact that they encompass species embraced by genus claim 46, from which claims 50 and 51 depend, as well as original claim 9, which was directed to encompass compositions as embraced by claims 46, 50, and 51. It is clearly set forth at 37 C.F.R. 1.146 that no restriction is proper among species embraced by a genus claim unless the species exceed a reasonable number. Applicants respectfully submit that original claim 9 as examined embraced many more species than the 23 reflected in claims 50 and 51 by SEQ ID

NOs: 5 to 27. Since no restriction could be properly made against the many more species of claim 9, how can the instant Restriction Requirement be properly supported.

In light of the above arguments, Applicants respectfully request reconsideration and withdrawal of the instant Restriction Requirement in favor of treating claims 50 and 51 as the genus claims that they are, followed by a search and examination of the claims as presented. In the event that the Restriction Requirement is maintained, Applicants elect SEQ ID NO:5 with traverse for the reasons provided above. In either event, Applicants look forward to examination, on their merits in their entireties, of claims 9-12, 14, 16, 46-50 and 52, along with at least SEQ ID NO:5 from claims 50 and 51. Upon determination of SEQ ID NO:5 as free of the prior art, Applicants look forward to extension of the search and examination to the next sequence recited in claim 50.

Applicants would appreciate an acknowledgement in the next PTO communication of the Information Disclosure Statement submitted on September 6, 2000.

If the Examiner believes a telephone conference would expedite prosecution of this application, she is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

*Karen Babyak Dow*  
Karen B. Dow  
Reg. No. 29,684

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: (415) 576-0200  
Fax: (415) 576-0300